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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,186	01/15/2004	Leonard Fuchs	30051/39757	5366
4743 7590 11/17/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER LEFT, STEVEN N	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/758,186

Applicant(s)

FUCHS, LEONARD

Examiner

STEVEN LEFF

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - The term “hot” in claims 1 and 7-9 is rejected, as it is a relative term, which renders the claim indefinite. The term “hot” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is encompassed by the phrase “hot”; it is unclear as to what degree of difference is encompassed by this phrase, if not “hot”. For instance, a non-frozen drink may be considered “hot” when compared to a frozen drink.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepler (5375508) as evidenced by Mercier (20020121197).

With respect to claims 1-9, Knepler teach a method for controlling a drink preparation machine for preparing a multiple number of different drink units on a hot-water basis (col. 8 line 50), comprising the steps of withdrawing the hot water for the multiple number of different drink units from a common hot water source (col. 4 lines 20-21), monitoring the performance status of the hot water source (col. 10 lines 58-69), and controlling the hot water withdrawal by enabling the hot water withdrawal for all of the multiple number of different drink units at a predetermined full performance status of the hot water (col. 10 lines 66-69), and blocking the hot water withdrawal for all of the multiple number of different drink units at a predetermined zero performance status of the hot water (col. 10 lines 61-63).

Further Knepler teaches that the full performance status comprises a performance range (col. 8 line 39), establishing a performance withdrawal value for each of the multiple number of different drink units, and deducting this performance withdrawal value from the performance status with each withdrawal (col. 4 lines 44-46), and heating the water synchronously with the withdrawal (col. 10 lines 58-66), determining the performance status of the hot water source prior to controlling the hot water withdrawal (col. 10 lines 66-69), and determining the performance status of the hot water source by determining a level of the water in a boiler (col. 4 lines 45-47), and/or the temperature of the water in the hot water source (col. 10 lines 58-66).

However Knepler is silent with respect to blocking the hot water withdrawal for at least one predetermined drink unit of the multiple number of different drink units and enabling hot water withdrawal for at least one predetermined drink unit of the multiple number of different drink units at a predetermined partial performance status of the hot water source.

Although Knepler et al. does not teach enabling hot water withdrawal for at least one predetermined drink unit of the multiple number of different drink units at a predetermined partial performance status of the hot water source, Knepler et al. does teach a water temperature sensor (col. 4 line 20), a level sensor (col. 4 line 23), and the desire to provide different batch sizes with respect to beverages (col. 9 lines 37-60), and thus it would have been obvious to one of ordinary skill in the art at the time of the

invention by the applicant to taught enabling hot water withdrawal for at least one predetermined drink unit of the multiple number of different drink units at a predetermined partial performance status of the hot water source since Knepler et al. teach the desire to provide a method of dispensing hot beverages using a temperature and liquid level sensor, and further since Knepler et al. teach the desire to not only provide different sized batches but further to provide the ability to dispense different liquids of different sizes (col. 9 lines 42-45) using a cpu thus increasing profits since the brewer continues to brew all the way to depletion of the water in the hot water tank as opposed to only being capable of brewing one large batch.

Thus since the cpu is capable of allowing the dispenser to be operated when one set of conditions are met but not necessarily a second set of conditions it would have been obvious to one of ordinary skill in the art at the time of the invention to teach a partial performance status which would provide the advantage of allowing the brewer to brew a "half" volume of the batch as opposed to the "full" volume of the batch as is desired by Knepler (col. 9 lines 45-57) thereby continuing to allow brewing of smaller batches when the amount of hot water available is not sufficient to brew an "extra large" batch thus increasing profits since the brewer continues to brew all the way to depletion of the water in the hot water tank as opposed to only being capable of brewing one large batch.

Further since Knepler et al. provides a cpu which would be capable of showing the status of the hot water source due to the temperature sensors, and teaching that inadequate beverages are due to insufficient water temperatures (col. 11 lines 1-2) it would have further been obvious to one of ordinary skill in the art at the time of the invention by the applicant to taught enabling hot water withdrawal for at least one predetermined drink unit of the multiple number of different drink units at a predetermined partial performance status of the hot water source since different beverages require different temperatures with respect to the hot water temperature for proper brewing, as is evidenced by Mercier et al. (par. 004) and thus the temperature sensor would further allow the cpu to correlate specific temperature ranges with respect to specific beverages. Therefore, in the instance that the temperature of the water in the hot water reservoir is outside of one specific temperature range, for instance for brewing coffee, but is in a proper temperature range for brewing tea, the cpu would be capable of allowing for the brewing and dispensing of one type of hot beverage at one specific

temperature range but not a second beverage which requires the water to be at a different higher or lower specific temperature range thus increasing sales with respect to the dispenser since customers desire different types of beverages which require different brewing parameters, as is further evidenced by Mercier et al. (par. 0004) where the different drinks rely on a single hot water source.

Further, since the only difference between the prior art and the claims was a recitation of relative performance status of the brewer with respect to the hot water, where Knepler et al. teach a cpu which is capable of calculating and showing this status it would have been obvious to one of ordinary skill in the art to teach delivering a beverage at a partial performance since Knepler et al. teach a cpu which is capable of computing these differences, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the methods, each of which is taught by the prior art to be useful for the same purpose, flows logically from their having been individually taught in the prior art (see MPEP 2144.06).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. With respect to applicant's argument that term "hot" is not a relative term, it is noted that applicant's invention relies upon the performance status of the hot water source. However as applicant stated in the response of 8/20/08 the term is with respect to making coffee, and/or tea however the phrase remains unclear since both coffee and tea may served either at one temperature or at temperature which is either hotter or colder with respect to the first temperature. Therefore since there is not reference point in the claim with respect to "hot", it is unclear as to what degree of difference is encompassed by this phrase, if not "hot". For instance, a non-frozen drink such as iced tea or iced coffee may be considered "hot" when compared to a frozen drink and thus it is unclear if the phrase is with respect to making both an iced tea or iced coffee beverage, or only coffee and tea beverages of a specific "hot" temperature .

It is initially noted that Mercier et al. is not used as a secondary reference but to provide evidence with respect to the examiners position that different beverages require different temperatures with respect to the hot water temperature for proper brewing, as is evidenced by Mercier et al. (par. 004).

With respect to applicant's argument that although Knepler teaches a cpu which is capable of performing the claimed method, this does not provide a proper basis for rendering that the method is would have been obvious. It is noted that since it is commonplace to apply modern electronics to older

mechanical devices it is the Office's view that since Knepler teach a water temperature sensor (col. 4 line 20), a level sensor (col. 4 line 23), and the desire to provide different batch sizes with respect to beverages (col. 9 lines 37-60), in addition to teaching a control circuit which includes an analog to digital converter which is coupled to a CPU including a portion of read-only memory as well as alterable memory (col. 11 lines 31-39), it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to teach a specific programming logic since different beverages require different temperatures with respect to the hot water temperature for proper brewing, as is evidenced by Mercier et al. (par. 004), and thus the sensors as is taught by Knepler would further allow the cpu to correlate specific parameters with respect to specific beverages, sizes and temperatures since the brewing apparatus is selectively connectable to an apparatus for making adjustments to various selectable functions of the brewer (col. 2 lines 40-45).

For example, in the instance that the temperature of the water in the hot water reservoir is outside of one specific temperature range, for instance for brewing coffee, but is in a proper temperature range for brewing tea, and since the cpu would be capable of allowing for the brewing and dispensing of one type of hot beverage at one specific temperature range but not a second beverage which requires the water to be at a different higher or lower specific temperature range due to the alterable memory as is taught by Knepler (col. 11 lines 31-39). Therefore since design incentives and market forces provide a reason to make an adaptation, where the recitation of specific programming logic with respect to a cpu as is taught by Knepler is a result of application of the prior art in a predictable manner it would have been obvious to one of ordinary skill in the art to teach specific programming logic since customers desire different types of beverages which require different brewing parameters, as is evidenced by Mercier et al. (par. 0004) where the different drinks rely on a single hot water source thus increasing sales with respect to the dispenser.

With respect to applicant's assertion that the examiner is relying on common knowledge or official notice, since Knepler does not teach or suggest operating in accordance with partial performance criteria, applicant is urged to column 9 lines 37-61 which teaches allowing the brewer to brew a "half" volume of the batch as opposed to the "full" volume of the batch or "other volumes", in addition to column 2 lines 40-45 which specifically teaches brewing apparatus being selectively connectable to an apparatus for making adjustments to various selectable functions of the brewer.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only

knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, Knepler teaches a CPU including an alterable memory being selectively connectable to an apparatus for making adjustments to various selectable functions of the brewer (col. 11 lines 31-39), in addition to teaching allowing the brewer to brew a "half" volume of the batch as opposed to the "full" volume of the batch or "other volumes" where design incentives and market forces provide a reason to make an adaptation.

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Drew E Becker/

Primary Examiner, Art Unit 1794

/Steven Leff/

Examiner, Art Unit 1794